

**REMARKS/ARGUMENTS**

**Status of the Claims.**

Claims 1-9, 16-64 are pending.

**The Present Amendments**

No new matter is added by the present amendments.

Claims 1, 17, 30 and 43 have been amended to recite that the food to which the gloss coating is applied has a solid surface. It is not the intent that the coatings would be applied to soups, stews, or yogurts. Support is found throughout the application, including claim 9 as originally presented. Claim 1 has also been amended by incorporating into the claim recitations previously recited in claims 11-15, which have accordingly been canceled. The claims have further been amended to recite that the gloss coatings stabilize at a high gloss value. All the gloss coatings studied lost some gloss over time, but the gloss coatings of the invention stabilized on chocolate at higher gloss values than did previous coatings and had slower gloss fade than did previous coatings. See, for example, specification page 7, paragraph ("para.") 16, and page 25, para. 77. Claims 1, 17, 30 43 and 54 have also been amended to remove the recitation of "wheat gluten".

**The Office Action**

The Office Action of January 18, 2007 (the "Action") rejects the claims on several grounds. Applicants amend in part and traverse the rejections. For the reader's convenience, the rejections are addressed below in the order in which they are presented in the action.

**1. Rejection of claims as obvious over U.S. Patent No. 6,869,628**

The Action rejects claims 1-63 on non-statutory obviousness-type double patenting as unpatentable over Krochta, U.S. Patent No. 6,869,628. The Action further rejects claims 1-63 under 35 U.S.C. § 103(a) as obvious. It indicates that both of these rejections can be overcome by a declaration that both the '628 patent and the current application are currently owned by the same person and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer. The present invention and the '628 patent are commonly owned and the John M. Krochta and Kirsten L. Dangaran named as inventors of the '628 patent are the same John M. Krochta and Kirsten L. Dangaran named as inventors of the application under examination. A declaration of Dr. John M. Krochta and a terminal disclaimer is enclosed.

**2. Rejection of claims as anticipated by McCabe or Best**

**(a) Rejections over McCabe.**

Claims 1-10, 14-22, 25, 28-39, 43-49, and 51-54 are rejected under §102(e) as anticipated by McCabe, U.S. Published Application 2003/0170347 or U.S. Patent No. 6,830,766 hereafter, "McCabe" "application" or "patent", respectively).

As an initial matter, Applicants note that the independent claims have been amended to contain recite that the coatings of the invention have a high gloss when applied to the solid surface of a food as an aqueous solution and then dried. The reference to solid surfaces is intended to clarify that the coatings are intended for use on foods with surfaces on which the coating solution can be dried. That the coatings provide a gloss was already recited in the claim preambles, but the further recitation clarifies that the gloss is indeed intended as a functional claim limitation.

Claim 1 has been amended to recite combinations of ingredients not taught by McCabe. The Action correctly states that Example 2 of McCabe teaches a coating that contains both whey protein isolate and soy protein isolate. The coating of McCabe Example 2, however, uses glycerine as a plasticizer. See, McCabe, page 5, paragraph 100. The Examiner will appreciate that the term "glycerine" is used interchangeably in the literature with "glycerol".

(For the Examiner's convenience, an information page on glycerin from the Soap and Detergent Association website and the Wikipedia entry on glycerol are attached.) Glycerol is excluded from the plasticizers encompassed by the claims under examination as, when used on foods, it was found not to form coatings with adequate or stable gloss. See, specification at page 7, lines 8-14. Thus, the formulation taught in Example 2 of McCabe would not result in a coating with a high or stable gloss and does not anticipate the claims under examination.

**(b) Rejections over Best**

Claims 1, 3-8, 14, 17-22, 25, 26, 30, 32-37, 43-49 and 51 are rejected under §102(e) as anticipated by Best, U.S. Published Application 2005/0118311 ("Best").

According to the Action, "Best discloses a low fat coating for foods that is glossy and contains a combination of sugar and hydrocolloid that may include protein." Applicants respectfully disagree. Best does not disclose that any of the coatings disclosed have a gloss. What the reference actually states is that gloss "is a function of surface topography" (Best, p. 6, para. 44), that a high gloss surface typically has a high roughness index, *id.*, and that gloss paints and matte finish paints can have the same particle size distribution, but differ in surface tension. *Id.* at para. 45. It then states that "[p]olymers are used in gloss paints to maximize the surface tension . . . For those of ordinary skill in the art, it is quite practical to control the effect to generate almost any desired degree of shininess or dullness based on the teachings herein." Figure 1 of Best states that it depicts high gloss being provided by coatings of the invention, but these are drawings, not photographs. And, at page 1, para. 8, Best states "The coating of the invention is also typically glossy in substantially the same manner as chocolate."

In other words, Best suggests but does not show that its coatings provide a high gloss. It does not state what the drawings it provides as Figure 1 are based on, and its statement that the coating of the invention "is typically glossy in substantially the same manner as chocolate is confusing at best, as uncoated chocolate does not have a high gloss - that is why commercial chocolates are currently coated with shellac. Best's comments about controlling gloss by controlling surface tension are an invitation to experiment; indeed, the comments would be unnecessary if the coatings the Best inventors presented in the Examples had the gloss they

recognized was important. Their problem may be tied to the fact that Best's coating are intended to provide a matrix of sugar crystals and sugar glass. Best, at page 1, para. 7. The present invention, however, indicates that formation of sugar crystals is undesirable, as it results in a lumpy, milky appearance rather than an even gloss. Specification, at page 13, para. 33. Thus, it is believed that the sugar crystal matrix Best provides may be disadvantageous in providing coatings with a high gloss. Finally, all the coatings of Best set forth in the Examples contain cocoa powder. The presence of entrapped cocoa particles would result in protrusions of the particles at the coating surface, further reducing its glossiness.

Accordingly, Applicants maintain that the coatings of Best do not anticipate the present invention.

### **3. Rejections of the claims as obvious.**

#### **(a). Rejections over McCabe**

The Action rejects claims 1-63 under §103(a) as obvious over McCabe, *supra*. The Action states that claim 1 appears to differ from McCabe in the recitation that the coating is a gloss coating, but dismisses that because "preamble limitations as to the appearance of the coating do not carry any weight in the claims." Action, at page 5.

While not necessarily agreeing with the Action, the claims have been amended to recite the presence of a stable gloss as a functional recitation. Since the obviousness rejection dismisses the difference between the McCabe coatings and those of the invention because the recitation of gloss in the preamble is not considered to be a functional recitation, it does not apply to the claims as amended.

The Action further applies McCabe to claims 55-63, which regard coating nuts to increase their shelf life. The Action contends this would have been an obvious application of the coating of McCabe. The Action explains that a practitioner would be motivated to apply the coatings of McCabe to nuts because the title of the McCabe reference is "High Protein Foodstuff" and nuts are high protein foodstuffs. Action, at page 6. Applicants traverse.

Even a casual reading of McCabe would convince the reader that the coatings are intended to address manufacturing problems specific to the production of sports bars, such as

short shelf life due to mold formation from failure to absorb internal moisture, McCabe application at p. 1, para. 4, which are not applicable to nuts. The Action's analysis that the person of skill would be motivated to apply the coatings to nuts since they are a "high protein foodstuff" assumes that the person of skill would simply apply the McCabe coatings to any foodstuff that has protein to regardless of the nature of the foodstuff involved. Steak is also a "high protein foodstuff," but a person of skill would not blindly apply the McCabe coatings to steaks simply because of the title. In the course of reviewing the reference, persons of skill would note what problems the coatings were intended to address, and contemplate whether the coating had any applicability to a problem they faced. Since nuts are not manufactured, and are not subject to the molding problems a protein bar might have due to internal moisture, Applicants respectfully maintain that the practitioner would have no motivation on the face of McCabe to use its coatings on nuts, other than the disclosure of the present specification.

The rejection suffers from a further problem in that there is no teaching as to how to modify the McCabe coatings so that they could be used to coat nuts. As discussed in the present specification, nuts have hydrophobic surface which causes water to bead on them. See, specification, page 16, para. 45. The person of skill would therefore expect that the McCabe coatings would not adhere to nuts and there would be no useful purpose to be served by applying them to nuts. In contrast, it is a discovery of the present invention that the addition of surfactants in amounts higher than those resulting in the lowest surface energy possible leads to adhesion. See, specification, page 17, para. 49. McCabe does not disclose the use of surfactants at all, let alone how to use surfactants to address problems with different surfaces. The Action provides no explanation how McCabe would motivate someone to provide coatings with surfactants at all, or how they would know to solve the problem of lack of adhesion to nuts with them. In the absence of any showing, the only inference is that the Action relies on the improper use of hindsight. Accordingly, Applicants respectfully maintain that the Action fails to set forth a proper *prima facie* case of obviousness with respect to claims 55-63.

**(b). Rejections over Cook**

Claims 1-10, 17-24, 30, 32, 33, 35-39, 43, 45-50, 54, 55, 57, and 61-63 are rejected under §103(a) as obvious over Cook, U.S. Patent No. 5,705,207 ("Cook"). Applicants amend in part and traverse.

Independent claims 1, 17, 30, and 43 have been amended to remove the reference to wheat gluten, obviating the rejection with respect to those claims and the claims dependent thereon.

Applicants traverse the rejection with respect to claims 55-63. As with the McCabe coatings, there is no teaching as to how to modify the Cook coatings so that they could be used to coat nuts. Nuts have hydrophobic surface which causes water to bead on them. See, specification, page 16, para. 45. The aqueous solutions taught by Cook, such as those of Examples 15-20, pointed to by the Action, would therefore not be expected to adhere to nuts. In contrast, it is a discovery of the present invention that the addition of surfactants in amounts higher than those resulting in the lowest surface energy possible allows the coatings to adhere to nuts. See, specification, page 17, para. 49. Cook does not appear to address this problem. The Action provides no explanation how Cook would motivate someone to provide coatings with surfactants at all, or how they would know to solve the problem of lack of adhesion to nuts with them. In the absence of any showing, the inference is that the Action relies on the improper use of hindsight. Accordingly, Applicants respectfully maintain that the Action fails to set forth a proper *prima facie* case of obviousness with respect to claims 55-63.

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Amdt. dated July 18, 2007  
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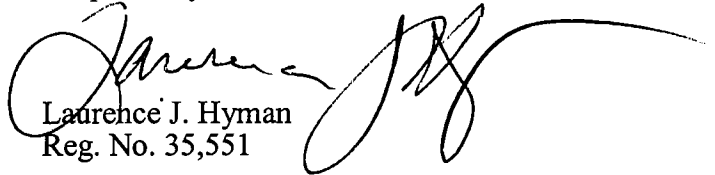
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**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

  
Laurence J. Hyman  
Reg. No. 35,551

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 415-576-0200  
Fax: 415-576-0300  
Attachments  
LJH:ljh  
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